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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,583	11/28/2003	Phillip Borunda	214.01-P-USA	8874

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FULWIDER PATTON LLP  
200 OCEANGATE, SUITE 1550  
LONG BEACH, CA 90802

EXAMINER
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LAUX, JESSICA L

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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11/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p align="center">10/724,583</p>	<p><b>Applicant(s)</b></p> <p align="center">BORUNDA, PHILLIP</p>	
	<p><b>Examiner</b></p> <p align="center">Jessica Laux</p>	<p><b>Art Unit</b></p> <p align="center">3635</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7, 9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 9, 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 09/10/2007 have been fully considered but they are not persuasive. However, in view of the amendments and additions to the claims Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 11-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the amendments and additions to the claims are supported by the drawings as originally filed they are not supported by the written description in the specification. Specifically the structure of the top cap and the stem are not described.

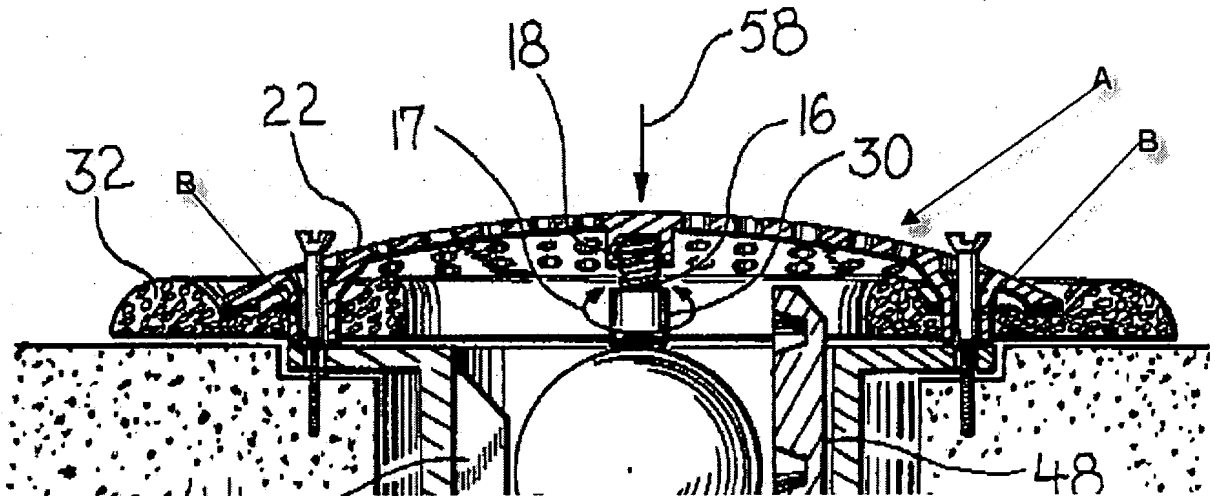
### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bromley (6295661).**

Regarding claim 1: Bromley discloses a device capable for use as a construction hole safety device, the device comprising:

a top cap (A, see annotated figure 2 below) having top and bottom surfaces and an underlying body stem (B) fixedly attached to the bottom surface of said cap and extending substantially perpendicularly from said bottom surface, said device made of sturdy, wear-resistant material (Col. 7, lines 37-39), wherein said body stem can fit within a man-made hole, and withstand the weight of people and construction equipment traveling thereon.



Regarding claim 2: The device of Claim 1, wherein said device is one piece (figure 2).

Regarding claim 3: The device of Claim 1, wherein the top cap and body stem are both substantially circular in configuration (where figure 8 shows a top view).

Regarding claims 11-12: The device of Claim 1, where the top surface of the top cap tapers downwardly from the center area of the cap towards the outside edge of said cap, and where the taper is in the form of a downward curve (figure 2).

Regarding claim 13: The device of claim 1, wherein said body stem comprises a hollow cylinder (figure 2).

Regarding claims 14-15: The device of Claim 1, wherein the body stem is sized to fit snugly into a construction hole by means of the body stem (figure 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5, 7, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bromley (6295661).**

Regarding claim 5: Bromley discloses the device of Claim 1, but does not expressly disclose that the top cap is larger in diameter at all points than the body stem by at least 1/8 inch. However, it can be seen in figure 2 of Bromley that the top cap has a larger diameter than the body stem.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the diameter of the top cap be at least 1/8 inch larger than the stem because applicant has not disclosed that such a dimension provides an advantage, is used for a particular purpose, or solves a stated

problem. One of ordinary skill in the art, furthermore, would have expected Bromley's cover device, and applicant's invention to perform equally well, because both cover devices would perform the same function of covering the hole equally well considering the common size of pool drains and the fact that any man made construction hole would vary in size.

Therefore, it would have been prima facie obvious to modify Bromley to obtain the invention as specified in claim 5 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Bromley.

Regarding claim 7: Bromley discloses the device of Claim 1, but does not expressly disclose that the device is comprised of high-impact polyethylene. Instead Bromley discloses that the device is composed of plastic or synthetic material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of Bromley to be polyethylene as polyethylene is a notoriously common and well used synthetic material. Furthermore upon reading the disclosure of Bromley, in which the broad limitation of any synthetic material is disclosed it would have been obvious to use polyethylene as the material choice, because it is easy to obtain and manufacture into desired articles.

**Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Bromley (6295661) in view of Johnson (5842811).**

Regarding claim 9: Bromley discloses the device of claim 1 above, but does not teach that the device bears warning labels attached to the top cap such that such labels

are clearly visible when the device is in use. Johnson teaches a device having a circular shape and a top used to cover man-made holes. The device has a plurality of warning signs positioned on the upper surface (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Lewis to have warning signs as taught by Johnson since the signs warn persons of potentially dangerous situations or areas.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-

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8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



/J. CHAPMAN/  
PRIMARY EXAMINER

JL  
10/25/2007